

REMARKS

Request for Corrected Form 892 and Corrected Copy of References

Counsel for applicant notes that certain references are incorrectly cited in the Form 892 and/or an incorrect copy of such references has been provided. A corrected copy of such references and a corrected copy of the Form 892 is respectfully requested. The following references identified in the Form 892 from Paper 13 require correction:

- (1) "www.inventnet.com, Screenprint, 11/7/1996" ("Inventnet");
- (2) "www.lloydwise.com" (no date) ("Lloydwise"); and
- (3) "PCT-Easy, User Reference Manual, January 1999,
<http://pcteasy.wipo.int/en/index.html>" ("WIPO").

Inventnet includes numerous pages that on their face raise a serious question as to the accuracy of the copy of the reference, the citation, and the asserted screenprint date of 11/7/1996:

- (a) page 1, listing "waybackmachine" and "Search Results for Jan 01, 1996 – Jan 27, 2003" and a print date (lower right hand corner) of "1/27/03";
- (b) page 8 has a url of
"http://web.archive/prg/web/19990209084002/www.inventnet.com/forms.html", the string "1999" indicating the year the document was archived;
- (c) page 11 has a print date of "1/27/03"; and
- (d) pages 12-16 have a print date of "1/22/03", and elements titled "New Patent Fees starting October 2001", "Images from Yankee Invention Exhibition 2000", and "Copyright © 1995-2002".

As one example, obviously the print date of all pages of the reference cannot be on the print date of November 7, 1996, asserted in the Form 892. Given the print dates in 2003, copyright dates in 2002, and archive date of 1999, it is respectfully submitted that the citation and/or content of the Inventnet reference is in error.

Lloydwise is cited without a date, although the face of the document includes a print date of "1/21/03". Clearly the Form 892 is incomplete with respect to this reference, at least.

WIPO apparently cites two separate documents: a manual and a web page. No copy of the cited web page was provided. It appears that the cited web page “<http://pcteasy.wipo.int/en/index.html>” is an index to various parts of a web site and hence cannot be the document provided. It is respectfully noted that each document requires a separate citation, and it is requested that a copy of the cited web page be provided.

Since the citations are incomplete, counsel for applicant respectfully points out the rules and regulations governing citations. 37 CFR § 1.104(d), MPEP § 707.05(e), MPEP § 901.05(a). Accordingly, the Examiner is respectfully requested to provide the available information, rather than withholding it from applicant. For example, if the references are available over the Internet, the Examiner is requested to provide an appropriate citation so that the references may be reviewed in their entirety. On the other hand, if the references are considered to be printed publications, the Examiner is respectfully requested to provide a print date and other appropriate citation details.

A letter correcting the errors together with a correct copy of the references and a corrected form 892 is respectfully requested. MPEP § 707.05(g).

If the citation and/or content of Inventnet, Lloydwise, and WIPO are not corrected, the Examiner is respectfully requested to withdraw the citations and to withdraw the rejections based thereon.

The claims stand rejected under 35 U.S.C. § 103(a) which requires that the subject matter “would have been obvious at the time the invention was made.” As the Examiner is well aware, references dated subsequent to the filing date of the application, i.e. September 30, 1999, cannot be used in a rejection under 35 U.S.C. § 103(a). Hence, applicant will not respond to those portions of references that are apparently unavailable for use in the rejection.

The Rejection

Claims 1 – 57 remain in the case. No amendments are made.

Claims 1 – 57 stand rejected under 35 USC § 103(a) as being unpatentable over www.inventnet.com (“Inventnet”) in view of The World Intellectual Property Organization PCT-Easy User Reference Manual, January 1999 (“WIPO”). For the reasons including, *inter alia*,

those discussed below, each of independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56, as amended is patentable over the applied references. Moreover, each of the claims dependent therefrom is patentable. The rejections are respectfully traversed for the reasons indicated below. Reconsideration of the application and withdrawal of the rejections are respectfully requested.

The Claimed Invention

The invention is directed to solving the problem of “preparing intellectual property filings in accordance with jurisdiction- and/or agent-specific requirements.”

The invention, as claimed, is directed to a “method of operating an information service to facilitate preparation of intellectual property documents suitable for filing in one or more of plural target jurisdictions (claim 1); an “information system for transacting an intellectual property filing with plural targets therefore,” (claim 5); a “method of operating an intellectual property filing portal for servicing intellectual property filing transactions using a network accessible information service,” (claim 15); a “computer-implemented method of operating a one-stop intellectual property filing service,” (claim 22); a “computer implemented method for initiating filing of one or more intellectual property related documents,” (claim 25, claim 33); a “computer implemented method of preparing one or more intellectual property filings,” (claim 41); “an information system for preparing intellectual property filings for at least one target in accordance with requirements therefor” (claim 44); “a computer program product encoded in a computer readable medium” (as claimed) (claim 52); “a method of making a computer readable encoding of one or more target jurisdiction- and associate-specific form documents” (claim 54); and “an intellectual property filing preparation system” (claim 56); all as further claimed.

By way of example, claim 1 recites, *inter alia*, “registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications.” As another example, claim 5 recites, *inter alia*, “supplying the originating node with particularized requirements of the selected at least one target jurisdiction and at least one associate.” As yet another example, claim 15 recites, *inter alia*, “responsive to a selection by a user of at least one target jurisdiction and at least one associate corresponding thereto, supplying the user, ... with a computer readable encoding of one or more form documents, wherein the form documents are specific to the at least

one target jurisdiction and at least one associate...” A further example is provided by claim 22, which recites, *inter alia*, “receiving at a computer, a transmission from a user, having at least one selection of two or more target jurisdictions and corresponding one or more associates for an intellectual property filing; in response to the at least one selection, supplying a transmission from the computer to the user, of one or more target jurisdiction and associate specific documents for completion;...” Claim 25, for example, recites, *inter alia*, “obtaining a computer readable encoding of one or more form documents, wherein the one or more form documents are specific to the target jurisdiction and to a respective associate therefor.”

Inventnet.com and PCT-Easy User Reference Manual (“WIPO”)

Independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56, and dependent claims 2-4, 6-14, 16-21, 23, 24, 26-32, 34-40, 42, 43, 45-51, 53, 55 and 57 stand rejected under 35 U.S.C. § 103(a) as being anticipated by www.inventnet.com (“Inventnet.com”) in combination with The World Intellectual Property Organization PCT-Easy User Reference Manual (“Wipo”). The rejections are respectfully traversed for the reasons given below.

Inventnet claims to be an Internet based inventor’s network. The Office Action states that the relevant portion of Inventnet includes registering patent attorneys in a “Patent Attorney Directory,” and contends that Inventnet further teaches registering for each of the plural associates, not only at least one target jurisdiction but also “a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications.” Assuming *arguendo* that Inventnet discloses a Patent Attorney Directory, it does not teach or suggest, for example registering form documents, or that the documents are “corresponding to target jurisdiction and associate specifications,” as claimed.

The Office Action admits that Inventnet fails to disclose distributing at least a portion of the form documents to an originating filer as further claimed. It follows that Inventnet fails to disclose anything regarding the form documents as claimed.

Nevertheless, recognizing that Inventnet fails to teach and/or suggest the invention as claimed, WIPO is cited to remedy the deficiencies. For reasons including the following examples, WIPO fails to remedy such deficiencies.

WIPO, published by the World Intellectual Property Organization, is a User Reference Manual for the PCT-EASY Electronic Application System. WIPO claims to be “software designed to facilitate the preparation of PCT international patent applications.” The cited document lists various limitations (e.g., page 1-3), for example, that WIPO’s documents conform solely to WIPO format.

Hence, Inventnet and WIPO, alone or in combination, fail to teach or suggest the combination of features recited in the claims.

Furthermore, Inventnet and/or WIPO operate in a fundamentally different way than the claimed invention. Specifically, neither Inventnet nor WIPO teach or even suggest, let alone disclose, anything concerning intellectual property documents suitable for filing by respective associates, nor registering a plurality of form documents corresponding to target jurisdiction and associate specifications. The Office Action cites the Patent Attorney Directory in Inventnet as disclosing this element, however, it is clearly deficient considering the invention as a whole. Consequently, the proposed combination fails to teach or suggest the claimed invention.

In addition, there is no suggestion or motivation to combine the references. The Office Action provides no motivation to combine the references, other than a statement in paragraph 8 that the combination would be made “for the advantage of operating an information service to facilitate preparation of intellectual property documents with the ability of users to select from a list of registered associates, be supplied the necessary form documents, and have the associate file for the intellectual property rights.” Inventnet itself does not provide a motivation to combine its patent attorney directory or other materials with WIPO’s Internet-based reference manual, nor does WIPO provide a motivation to offer inventor group materials of any type. To the contrary, Inventnet teaches that its users use a patent attorney to prepare the necessary documents (“Patenting Help” page screen).

Assuming *arguendo* the suggested motivation, the proposed combination of references still fails to teach or suggest the invention as claimed. For example, the combination of WIPO and Inventnet still fail to provide an “ability for users to select from a list of registered associates the necessary form documents, and have the associate file for the intellectual property rights.”

Assuming *arguendo* a motivation to combine the two references, the proposed modification

would appear to change the principle of operation of either Inventnet or WIPO, or both.

Inventnet does not appear to be appropriate for offering users the PCT-EASY User Reference Manual. Further, the WIPO reference manual is not a “plurality of form documents corresponding to target jurisdiction and associate specifications”, registered for each of plural associates. Hence, the proposed combination would appear to require some basic changes to the fundamental principles upon which Inventnet and WIPO operate in order for each to accommodate the other in the manner proposed by the Examiner.

Moreover, assuming *arguendo* that it may have been possible to access both over the Internet, that in itself provides no motivation to combine the references as proposed by the Examiner.

Further, with regard to independent claims 5, 15, 22, 25, 33 and 56, the Office Action again fails to specify the reasons for rejection particular to each claims.¹ Further, the Office Action fails to cite any particular portion of any reference supporting the rejection.² If the Examiner maintains this rejection, he is respectfully requested to remedy the lack of citation and reasoning, so that applicant may respond substantively thereto.

For at least these reasons, the combination of features recited in independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56 when interpreted as a whole, is submitted to patentably distinguish over the prior art.

With regard to claims 35-36 and 49, the first Office Action argued that it would have been

¹ The omnibus rejection of independent Claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56 in paragraphs 5-8 of the office action is respectfully traversed. It appears that the rejection is applied only to claim 1. According to the MPEP, “a plurality of claims should never be grouped together in a common rejection, unless that rejection is *equally applicable* to all claims in the group.” MPEP § 707.07(d). Nevertheless, counsel for applicant will respond as best understood, in order to advance prosecution.

² Counsel for applicant respectfully traverses the failure of the Office Action to cite a specific location in a reference for support. This is a particularly egregious omission where the reference such as WIPO is more than one hundred pages long. If the Examiner maintains the rejections, he is respectfully requested for each and every rejection to provide specific locations in the references. Accordingly, the Examiner is again respectfully requested to provide the required citations to a particular part of the reference(s). 37 C.F.R. § 1.104(c)(2).

obvious to include contents of a priority application (claim 35), data retrieved from a docket system (claim 36) or a priority application corresponding to a previously filed intellectual property application (claim 49). The Examiner previously took notice that allegedly these are well known information fields that are part of the application process at the United States Patent and Trademark Office. Applicant previously requested that if the Examiner maintains his position that a computer readable encoding of intellectual property data includes the contents of a priority application, includes the data retrieved from a docket system, and includes priority application corresponding to a previously filed intellectual property application, respectively, that he should provide the required evidence thereof. MPEP § 2144.03. It appears that the Examiner has cited the entire contents of a one hundred-plus page document. Applicant has carefully reviewed the cited documents in their entirety but was unable to locate each of such specifics. Accordingly, the Examiner is respectfully requested to withdraw the citation or to provide a specific location in the document(s), as is required.

As per claims 2-4, 6-14, 16, 20-21, 24, 26-32, 34, 37-40, 42, 48, 53-55, and 57 the Office Action fails to cite any particular portion of any reference supporting the rejection. It appears that the Examiner has cited, *inter alia*, the entire contents of a one hundred-plus page document. Applicant has carefully reviewed the cited documents in their entirety but was unable to locate such specifics. Accordingly, the Examiner is respectfully requested to withdraw the citations and rejections or to provide a specification of a particular part of the reference(s). 37 C.F.R. § 1.104(c)(2).

In any event, it is respectfully submitted that the references, either alone or in combination, fail to teach or suggest the invention as claimed in these claims. Nevertheless, if the Examiner maintains this rejection, he is respectfully requested to remedy the lack of citation and reasoning, so that applicant may respond substantively thereto.

With respect to the rejected dependent claims, Applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 or 56, but also because of additional features they recite. Examples of some of these features were discussed previously.

Summary

Applicant respectfully submits that, as described above, the cited prior art does not teach or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Conclusion

For all the reasons advanced above, Applicant respectfully submits that the rejection of claims 1-57, insofar as it may be applied to the claims as amended, must be withdrawn. Consequently, issuance of a Notice of Allowance is respectfully requested.

AUTHORIZATION

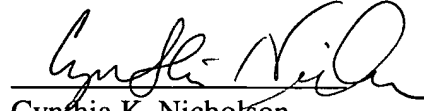
The Commissioner is hereby authorized to charge any additional fee that may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of

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time to deposit account no. 08-0219.

Respectfully submitted,



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